

Appln. No. 10/757,932  
Docket No. 14XZ124318/GEM-0129

### **REMARKS / ARGUMENTS**

#### **Status of Claims**

Claims 1-42 are pending in the application. Claims 1-23, 30, 32-38, 40 and 41 stand rejected. Claims 24-29, 31 and 39 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims. Applicant has amended Claims 1-4, 13 and 42, leaving Claims 1-42 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

#### **Objections to the Claims**

Claim 42 is objected to for informalities relating to the omission of a word.

Applicant has amended Claim 42 as suggested by the Examiner.

Accordingly, Applicant requests reconsideration and withdrawal of these objections.

#### **Rejections Under 35 U.S.C. §112, Second Paragraph**

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as the invention.

Appellant traverses this rejection for the following reasons.

Applicant submits that where the claims define patentable subject matter with a reasonable degree of particularity and distinctness, the claims should be allowed. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as may be desired. Claims should not be rejected if the expression selected by Applicant satisfies the statutory requirements. In

Appl. No. 10/757,932  
Docket No. 14XZ124318/GEM-0129

viewing a claim for compliance with 35 U.S.C. §112, second paragraph, the claim as a whole must be considered to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the required notice function. MPEP 2173.02. (Emphasis in the original).

The Examiner alleges that Claim 1 fails to comply with 35 U.S.C. §112, second paragraph, but does not state with specificity where the claim language itself is lacking. Instead, the Examiner references Applicant's reply filed 07/25/05 by stating "Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in reply filed 07/25/05. In that paper, applicant has stated that the invention is for filtering radiation, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no radiation for the purpose of filtering in the claim." Paper 100105, page 2.

At the outset, Applicant respectfully submits that the Examiner has misquoted Applicant's reply filed 07/25/05, which more specifically states "...the *structure of a filtration system*, suitable for filtering emitted radiation for example..."(emphasis in the original). Here, Applicant first states that the invention of Claim 1 is directed to *structure*, and then states that the structure is *suitable* for filtering emitted radiation, which is consistent with the specification as originally filed.

From the foregoing reason set forth by the Examiner, it is unclear to Applicant exactly what language, by line number, is objectionable to the Examiner, and it appears to Applicant that the Examiner is looking for some reference in Claim 1 to language that refers to "for filtering radiation".

While Applicant respectfully submits that Claim 1 complies with 35 U.S.C. §112, second paragraph, without amendment, Applicant has nonetheless, in an effort to advance this case to issue, amended Claim 1 to now recite "A radiation filtering system *suitable for filtering radiation...*", and then sets forth the elements of the system. No new matter has been added as antecedent support may be found in the specification as originally filed, such as at Paragraph [0009], for example. Applicant also submits that the amended language is consistent with Applicant's reply filed 07/25/05.

Appl. No. 10/757,932  
Docket No. 14XZ124318/GEM-0129

In Claim 1, Applicant is not claiming a radiation filtering system that includes a source of radiation, but instead is claiming a radiation filtering system that is suitable for filtering radiation. As such, Applicant submits that the elements of Claim 1 are commensurate in scope with the preamble of Claim 1, that the specification is commensurate in scope with the claimed structure of now amended Claim 1, and respectfully submits that the claimed invention is not contrary to Applicant's reply filed 07/25/05.

In view of the foregoing, Applicant respectfully submits that the claimed subject matter is described in such a manner that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, defined the claimed subject matter with a reasonable degree of particularity and distinctness to set forth the subject matter that Applicant regards as the invention, and therefore respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §112, second paragraph, which Applicant considers to be traversed.

**Rejections Under 35 U.S.C. §102(b)**

Claims 1 and 42 stand rejected under 35 U.S.C. §102(b) as being anticipated by Carpenter (U.S. Patent No. 4,176,916, hereinafter Carpenter).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \*\*\* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "*arranged as in the claim.*" *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984) (emphasis added). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of

Appln. No. 10/757,932  
Docket No. 14XZ124319/GEM-0129

another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claim 1 to now recite, inter alia,

“... a plurality of filtering plates of which a selected one or more of the plates can be conveyed to and oriented in a stationary position for use;

means for causing a selection of one or more of the plates and allowing for continuous conveyance thereof and for stationary positioning thereof;

the plates being fixed to the means for causing a selection by means of a joint; and

means for modifying an orientation of a stationary plate about its respective joint.”

Dependent claims inherit all of the limitations of the parent claim.

No new matter has been added as antecedent support may be found in the specification as originally filed, such as at Paragraph [0016] for example.

In comparing Carpenter to the instant invention, Applicant finds Carpenter to disclose “... a *constant drive motor 3* having a tachometer 3a *to cause the filter wheel 1 to rotate at a constant speed of angular velocity  $\omega$*  ... and a stationary, circular cam track 5...”. Column 3, lines 46-60, and Figures 1 and 2 (emphasis added).

Contrary to the claimed invention, Applicant finds Carpenter to disclose a *constantly rotating filter wheel*, and to be absent disclosure of each and every element of the claimed invention arranged as claimed. More specifically, Applicant finds Carpenter to be absent disclosure of:

“... a plurality of filtering plates of which a selected one or more of *the plates can be conveyed to and oriented in a stationary position* for use;

means for causing a selection of one or more of *the plates and allowing* for continuous conveyance thereof and *for stationary positioning thereof*;

the plates being fixed to the means for causing a selection by means of a joint; and

*means for modifying an orientation of a stationary plate* about its respective joint.”

Accordingly, Applicant submits that Carpenter does not disclose all of the claimed elements arranged as in the claim, and absent anticipatory disclosure in Carpenter of each

Appl. No. 10/757,932  
Docket No. 14XZ124318/GEM-0129

and every element of the claimed invention arranged as in the claim, Carpenter cannot be anticipatory.

Regarding Claim 42

Claim 42 is dependent upon Claim 1 and therefore inherits all of the limitations of Claim 1. As such, and for at least this reason, Applicant submits that Claim 42 is allowable. Additionally, however, Applicant has amended Claim 42 for consistency of language.

In view of the amendment and foregoing remarks, Applicant submits that Carpenter does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 2-23, 30, 32-38, 40 and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schukalski (U.S. Application Publication No. 2002/0186817, hereinafter Schukalski) in view of Carpenter (U.S. Patent No. 4,176,916, hereinafter Carpenter).

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention arranged so as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

The Examiner acknowledges that Schukalski is deficient in anticipating each and every element of the claimed invention, and looks to Carpenter to cure these deficiencies.

Appln. No. 10/757,932  
Docket No. 14XZ124318/GEM-0129

More specifically, the Examiner looks to Carpenter for teaching "the plates being fixed to the means for causing a selection by means of a joint; and means for modifying an orientation of a plate about its respective joint including a ramp so that the filtration plate rotates about a joint as a result of motion of the distributor." Paper 100105, page 4.

Applicant has amended Claims 2-4 and 13 to now include limitations directed to a "stationary" filtration plate, and "stationary positioning" of a filtration plate.

Dependent claims inherit all of the limitations of the respective parent claim.

In comparing the References with the claimed inventions, Applicant finds Schukalski to be deficient for the same reasons as set forth by the Examiner, and finds Carpenter to be deficient in any teaching of a "stationary" filtration plate or "stationary positioning" of a filtration plate, as discussed above with reference to the rejection under 35 U.S.C. §102(b).

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

#### **Allowable Subject Matter**

Claims 24-29, 31 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable is rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's remarks regarding the allowability of the noted claims. However, in view of Applicant's remarks set forth above, Applicant submits that Claims 24-29, 31 and 39 are allowable, and respectfully requests notice of allowance thereof.

Appln. No. 10/757,932  
Docket No. 14X2124318/GEM-0129

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 50-2513.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP

Applicant's Attorneys

By: 

David Arnold  
Registration No: 48,894  
Customer No. 23413

Address: 55 Griffin Road South, Bloomfield, Connecticut 06002  
Telephone: (860) 286-2929  
Fax: (860) 286-0115